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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,301	09/28/2001	Simon Lawrence John Stubbs	PA-0111	5224

22840 7590 01/14/2005

AMERSHAM BIOSCIENCES  
PATENT DEPARTMENT  
800 CENTENNIAL AVENUE  
PISCATAWAY, NJ 08855

EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/967,301

Applicant(s)

STUBBS ET AL.

Examiner

Hope A. Robinson

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 first and second paragraphs.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 26-32.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 11,13-18 and 33.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The drawing correction filed on 28 September 2001 is a) ☐ approved or b) ☒ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's response to the Final Office Action mailed October 13, 2004 on December 16, 2004 is acknowledged.

2. Applicant's arguments filed December 16, 2004 have been fully considered but are not persuasive.

The rejection under 35 U.S.C. 102 (b) has been maintained.

3. Claims 1-10, 12 and 19-25 have been cancelled. Claims 11, 14, 18, 26, 28 and 32 have been amended. Claims 11, 13-18 and 26-33 are pending and are under examination.

4. Claims 11, 15-17 and 33 remain rejected under 35 U.S.C. 102(b). Applicant's response states that the examiner misread the protein sequence listed on column 39 (SEQ ID NO:4) of Tsein et al. (U.S. Patent No.6,077,707). It is stated that the protein sequence of Tsein et al. is engineered utilizing mammalian codons and optimal Kozak sequence (col. 2, lines 45-49). Applicant further state that the sequence contains an additional Val (V2) between the first (Met) and second (Ser) amino acid sequence of the wildtype GFP sequence. Thus, the numbering of each subsequence amino acids of the patented SEQ ID NO:4 is shifted one from the wildtype sequence. Thus the claimed mutations are not taught by the reference. This argument is not persuasive because

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column 2 of the patent at the lines pointed to by applicant does not make the above assertion. Furthermore, SEQ ID NO:4 of the patent clearly discloses the following F64T; E222L and S175G. Therefore, the patent is relevant to the claimed invention as the sequence listing in the patent discloses a sequence that anticipates the present claims. Thus, the rejection remains.

Note that the rejections under 35 U.S.C. 112 first and second paragraphs, and objections to the specification and claims, have been withdrawn.

5. The drawings are objected to because Figures 1-4 discloses SEQ ID NOS: 1-4, however, the sequence notation is noted as "SEQ ID No." which does not comply with the sequence rules. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

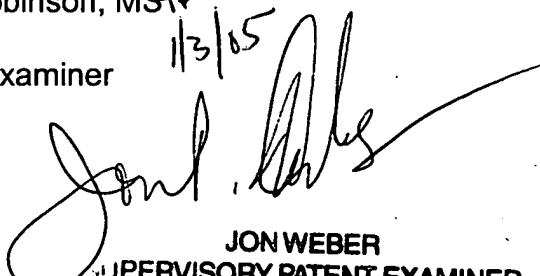
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday from 9:00 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber, can be reached at (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hope Robinson, MS<sup>12</sup>

Patent Examiner

1/3/05  
  
JON WEBER  
SUPERVISORY PATENT EXAMINER